

REMARKS

I. General Remarks

The application has been reviewed in light of the Non-Final Office Action mailed July 26, 2005. At the time of the Non-Final Office Action, claims 1-24 were pending in this application. Claims 1 and 5 have been amended herein. Applicants gratefully acknowledge Examiner's designation of claims 5-16 and 19-34 as allowable subject matter.

Claims 1- 34 stand rejected in view of prior art. For the reasons discussed below, the Applicants believe that all of the remaining claims are patentable over the cited prior art, and therefore respectfully traverse Examiner's rejection.

II. Rejections under 35 U.S.C. § 102(b)

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by either U.S. Patent 6,561,275 issued to Glass *et al.* [hereinafter *Glass*] or U.S. Patent No. 6,457,528 issued to Staudt *et al.* [hereinafter *Staudt*].

Examiner writes as follows:

The claimed structure reads exactly on the reference's structure when the frangible rupture disk 13 is considered as the "valve" as recited. The rupture disk 13 is designed to burst at a predetermined fluid pressure.

See Office Action at 2. Applicants respectfully submit that the "at least one valve" recited in claim 1 is not a rupture disc. As described in the Specification, the rupture disc(s) of the present invention may be used in conjunction with the "at least one valve" of claim 1. *See e.g., Specification, ¶¶ 14, 49-51 and Figures 11A-11C.* Figures 11A-11C show one example of how rupture discs may be used in conjunction with the "at least one valve" of claim 1. Rupture discs 210 and 212 are disposed within a pair of inlet ports 206 and 208 to block the flow of fluid into the central bore until the annular fluid pressure reaches a desired predetermined burst value. In

this way, rupture discs 210 and 212 may protect a downstream valve (such as the valve depicted in Figure 11C) from exposure to fluids and solids, which could cause plugging and/or other operational problems to the valve downstream of the rupture discs.

As set forth in MANUAL OF PATENT EXAMINING PROCEDURE § 2111.01(II), Rev. 3 (2005), claim terms should be interpreted according to their ordinary and customary meanings as understood by a person of ordinary skill in the art at the time of the invention. Indeed, the M.P.E.P. explains as follows:

[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Phillips v. AWH Corp.*, ___ F.3d ___, 75 USPQ2d 1321 (Fed. Cir. 2005) (en banc).< *Sunrace Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003); *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 67 USPQ2d 1132, 1136 (Fed. Cir. 2003) ("In the absence of an express intent to impart a novel meaning to the claim terms, the words are presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art."). It is the use of the words in the context of the written description and customarily by those skilled in the relevant art that accurately reflects both the "ordinary" and the "customary" meaning of the terms in the claims. *Ferguson Beauregard/Logic Controls v. Mega Systems*, 350 F.3d 1327, 1338, 69 USPQ2d 1001, 1009 (Fed. Cir. 2003).

M.P.E.P. § 2111.01(II). Nowhere in Applicants' Specification is it taught that that the term "valve" encompasses a rupture disc. Accordingly, these terms should be given their ordinary and customary meanings as understood by a person of ordinary skill in the art at the time of the invention interpreted in light of Applicants' Specification. Thus, Applicants respectfully submit that Applicants' Specification does not vary the term "valve" as used in claim 1 so as to include a "rupture disc."

Given that the term "valve" as used in claim 1 does not include a "rupture disc,"

the cited references, *Glass* and *Staudt*, each fail to anticipate Applicants' claim 1. To form a

basis for a 35 U.S.C. § 102(b) rejection, a prior art reference must disclose each and every element as set forth in the claim. *See* M.P.E.P. § 2131. In particular, *Glass* and *Staudt* each fail to teach or suggest “at least one valve disposed in the housing, which opens in response to a predetermined annular fluid pressure enabling fluid to pass from an outer annulus between adjacent nested casing strings disposed outside the housing to an annulus between different adjacent nested casing strings disposed inside the hollow inner cavity.” Thus, the cited references, each standing alone, do not contain each and every element of the claimed invention and as such, not one of them anticipates Applicants’ as amended claims.

III. Rejections under 35 U.S.C. § 103(a)

Claims 2-4, 17, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over either U.S. Patent 6,561,275 issued to *Glass et al.* [hereinafter *Glass*] or U.S. Patent No. 6,457,528 issued to *Staudt et al.* [hereinafter *Staudt*] in view of U.S. Patent No. 5,697,442 issued to *Baldridge et al.* [hereinafter *Baldridge*] or Great Britain Patent No. GB 2,171,436 issued to *Mikolajczyk et al.* [hereinafter *Mikolajczyk*].

A. The Cited References Do Not Teach All Claim Limitations of Applicants’ Claims

A prima facie case of obviousness requires a showing that all claim limitations be taught or suggested by the art. M.P.E.P. § 2143.03. Applicants respectfully submit the combination of *Glass* or *Staudt* in view of *Baldridge* or *Mikolajczyk* fail to yield a process within the scope of the claims. *Glass*, *Staudt*, *Baldridge*, and *Mikolajczyk* fail to form a proper basis for a prima facie case of obviousness, because they fail to teach all of the limitations of the claimed invention.

In particular, as to independent claim 1, the cited references fail to teach “at least one valve disposed in the housing, which opens in response to a predetermined annular fluid

pressure enabling fluid to pass from an outer annulus between adjacent nested casing strings disposed outside the housing to an annulus between different adjacent nested casing strings disposed inside the hollow inner cavity.” As explained above in Section II, the term “valve” as used in claim 1 does not include a rupture disc.

Accordingly, the cited references cannot form a proper basis for a prima facie case of obviousness. As such, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection as to dependent claims 2-4, 17, and 18 which depend from independent claim 1.

B. No Motivation to Combine the Cited References Exist in the Cited References

A prima facie case of obviousness requires a suggestion or motivation in the prior art references to make the specific combination of elements claimed by Applicants. M.P.E.P. § 2143.01 (citing *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held *improper*.); *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.)). The cited prior art references contain no such motivation or suggestion to combine the elements of *Glass or Staudt* in view of *Baldrige* or *Mikolajczyk* to arrive at the specific combination of elements claimed by Applicants.

Examiner writes, in part, as follows:

... it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the well casing of Glass et al. or Staudt with such blades as claimed because either Baldrige or Mikolajczyk teach providing a well casing with a stabilizer including such blades in order to maintain the casing centered, thereby providing a cement column of substantially uniform thickness (col. 1, line 48 though column 2, line 6 in Baldrige; page 1, lines 12-21).

Office Action at 2-3. Applicants respectfully submit that Examiner has not pointed to any suggestion or motivation to combine the teachings of *Glass*, *Staudt*, *Baldrige*, and *Mikolajczyk* that is present in the cited references themselves. Examiner has provided no evidence or finding of the specific understanding or principle within the knowledge of a person of ordinary skill in the art at the time of the invention that would have supplied the motivation to combine the cited references. *See* M.P.E.P. § 2143.01.

Further, as provided in M.P.E.P. § 2144.03(C), a conclusion as to the supposed action of a person of ordinary skill in the art is insufficient to establish a *prima facie* case of obviousness. To the extent that Examiner relies on such a statement or statements to supply the necessary motivation to combine or modify the prior art references, Applicants hereby respectfully traverse the lack of such a showing and request under M.P.E.P. § 2144.03(C) that Examiner supply an affidavit or other documentary proof establishing the prior art knowledge that would have motivated a person of ordinary skill in the art to make the specific modification and/or combination of elements to arrive at Applicants' invention.

Additionally, Applicants respectfully point out that the Federal Circuit has made clear that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01 (citing *In re Mills*, 916 F.2d 680,682 (Fed. Cir. 1990)). The M.P.E.P. also makes clear the requirement that Examiner provide objective reasons to combine the references apart from naked statements that "it would be obvious to a person of ordinary skill." M.P.E.P. § 2143.01 (explaining that "A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the

claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.” (citations omitted)).

Thus, Applicants respectfully submit that it is inappropriate to combine *Glass*, *Staudt*, *Baldrige*, and *Mikolajczyk*. Further, the cited references contain no suggestion or motivation to combine or to modify the references to arrive at the specific combination of elements of Applicants’ claims. Thus, Applicants respectfully request the removal of the 35 U.S.C. § 103(a) rejection as to dependent claims 2-4, 17, and 18 which depend from independent claim 1.

SUMMARY

In light of the above amendments and remarks, Applicants respectfully submit that the application is now in condition for allowance and early notice of the same is earnestly solicited. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile or electronic mail, as indicated below.

Applicants believes that no fees are due in association with the filing of this Response. However, should the Commissioner deem that any fees are due, including any fees for any extensions of time, Applicants respectfully request that the Commissioner accept this as a Petition therefore, and directs that any fees be debited from Baker Botts L.L.P., Deposit Account No. 02-0383, (*formerly Baker & Botts, L.L.P.*) Order Number 063718.0427.

Respectfully submitted,

BAKER BOTTS L.L.P.

By: 

Paul R. Morico
Registration No. 35,960
One Shell Plaza
910 Louisiana Street
Houston, Texas 77002-4995
Telephone: 713.229.1732
Facsimile: 713.229.7732
email: paul.morico@bakerbotts.com
ATTORNEY FOR APPLICANT

Date: October 19, 2005